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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Scott Gerald Allam

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7590

04/04/2006

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EXAMINER

QUELER, ADAM M.

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,598

Applicant(s)

ALLAM ET AL.

Examiner

Adam M. Queler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 01/20/2006.
2. Claims 1-58 are pending in the case. Claims 1, 44, 46, and 57 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-4, 6-18, 21-28, 30-38, 42-47, 49-52 and 55-58 remain rejected under 35**

U.S.C. 102(b) as being anticipated by Rivette et al. (US006018749A, filed 4/9/1998)

hereinafter Rivette-749.

Regarding independent claims 1, 44, 46, and 57, Rivette-749 teaches displaying in a first window a physical page (Fig. 59). The window surrounding the text is the visual reference, which is disposed on the physical page. Rivette-749 teaches extracting the information on the physical page (col. 19, line 65 – col. 21, line 11). Rivette-749 teaches presenting the extracted information in a second window and that the information is free-flowing (Fig. 59).

Regarding dependent claim 2, Rivette-749 teaches the physical page is represented in an electronic page view (Fig. 59).

Regarding dependent claim 3, Rivette-749 discloses that the physical page is represented as an icon including a thumbnail of the physical page (Fig. 65).

Regarding dependent claim 4, Rivette-749 discloses the first and second windows are the same window (Fig. 59, Patentworks window).

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Regarding dependent claim 6, Rivette-749 discloses the step of extracting information further comprises the step of selecting a markup annotation from the physical page and converting the information contained in the selected markup annotation to information for use in the second window (col. 41, ll. 18-44).

Regarding dependent claim 7, Rivette-749 discloses the step of selecting further comprises the step of enclosing the markup annotation with a box (Fig. 61).

Regarding dependent claim 9, Rivette-749 discloses the second window further comprises a control panel for managing the extracted information (col. 33, ll. 64-67.).

Regarding dependent claim 10, Rivette-749 discloses the extracted information may be viewed simultaneously in a multiple of enhanced interactive windows (col. 37, ll. 39-55).

Regarding dependent claim 11, Rivette-749 discloses the visual reference on the physical page is a box with a colored border (Fig. 59).

Regarding dependent claim 12, Rivette-749 discloses the step of extracting information further comprises the step of extracting information when a computer user clicks in the first window by a selection device including a mouse and the information, which is extracted, is around the point of the mouse click (col. 25, ll. 36-43).

Regarding dependent claim 13, Rivette-749 discloses selecting a bookmark and retrieving information associated with the bookmark (col. 41, ll. 19-45).

Regarding dependent claim 14, Rivette-749 discloses retrieving information associated with a structural element when the user selects the structural element (col. 33, ll. 50-62)

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Regarding dependent claim 15, Rivette-749 discloses the information emphasized by a visual reference is termed a markup annotation and each markup annotation is associated with a structural element stored in a database of structural elements (col. 4, ll. 21-37).

Regarding dependent claim 16, Rivette-749 discloses retrieving an associated structural element from a database of structural elements and displaying data from the markup annotations associated with the structural elements in the second window (col. 41, ll. 19-45).

Regarding dependent claim 17, Rivette-749 discloses enlarging and reducing visual elements (col. 36, ll. 17-34).

Regarding dependent claim 18, Rivette-749 discloses that the visual elements include graphic images, clip art, and picture objects (col. 36, ll. 17-34).

Regarding dependent claim 21, Rivette-749 discloses selecting a symbol representing extracted information in the second window, and displaying document elements associated with the symbol in the first window (col. 41, ll. 19-45).

Regarding dependent claim 22, Rivette-749 discloses that the symbol includes icons for figures (col. 36, ll. 41-46).

Regarding dependent claim 23, Rivette-749 discloses that selecting a symbol further comprises the step of enlarging or reducing a zoom view of the extracted information in the first window (col. 36, ll. 17-34).

Regarding dependent claim 24, Rivette-749 discloses that selecting a symbol displays the extracted information in a third window (col. 37, ll. 39-55).

Regarding dependent claim 25, Rivette-749 discloses that selecting a symbol displays text in another enhanced interactive window (col. 37, ll. 39-55).

Regarding dependent claim 26, Rivette-749 inherently discloses executing code as the system of Rivette-749 is software based.

Regarding dependent claim 27, Rivette-749 discloses that document elements include information comprising tables, figures, graphs, charts, illustration graphics, photos, clip art audio and audiovisual elements (Fig. 59).

Regarding dependent claim 28, Rivette-749 discloses that the step of selecting includes clicking on the symbols with a mouse (col. 41, ll. 19-45).

Regarding dependent claims 8 and 30, Rivette-749 discloses the window may be moved anywhere (col. 46, ll. 13-30).

Regarding dependent claim 31, Rivette-749 discloses that all functions maybe accessed without clicking (col. 26, line 36 – col. 27, line 2).

Regarding dependent claim 32, Rivette-749 discloses that the step of displaying extracted information further comprises the step of advancing extracted information in the second window by an action including a keystroke (col. 26, line 36 – col. 27, line 2).

Regarding dependent claim 33, Rivette-749 discloses that the step of advancing extracted information in the second window further comprises the step of advancing the physical page displayed in the first window (col. 17, ll. 17-25).

Regarding dependent claim 34, Rivette-749 discloses that the step of advancing extracted information in the second window further comprises the step of advancing the visual reference to the extracted information in the physical page displayed in the first window (col. 17, ll. 17-25).

Regarding dependent claim 35, Rivette-749 discloses that the extracted information will start at the top of the second window (Fig. 59).

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Regarding dependent claim 36, Rivette-749 discloses the step of creating a summary document from user created notes, highlights, and other user inputted information (col. 41, ll. 18-44).

Regarding dependent claim 37, Rivette-749 discloses that the step of presenting extracted information further comprises the step of allowing the user to add to the extracted information in the second window (col. 41, ll. 18-44).

Regarding dependent claim 38, Rivette-749 discloses that the step of presenting extracted information further comprises the step of finding words within the second window (col. 30, ll. 26-49).

Regarding dependent claim 42, Rivette-749 discloses that the electronic information is associated with a particular computer (col. 13, ll. 45-54).

Regarding dependent claims 43 and 55, Rivette-749 discloses that the electronic information may be shared between computer users and between computers (col. 13, ll. 52-66).

Regarding dependent claim 45, Rivette-749 discloses selecting extracted information represented by symbols in the second window, and displaying document elements associated with the symbols in a third window (col. 41, ll. 19-45).

Regarding dependent claim 47, Rivette-749 discloses that the enhanced interactive window comprises at least one window that displays extracted information from the physical pages (Fig. 59).

Regarding dependent claim 49, Rivette-749 discloses a database for storing annotations, extracted electronic information, and the relationships in the system (Fig. 3, 60).

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Regarding dependent claim 50, Rivette-749 discloses structure tree for storing relationship information associating electronic information with extracted electronic information (col. 52, ll. 56-61).

Regarding dependent claim 51, Rivette-749 discloses a visual reference emphasizing the electronic information is displayed on the physical pages (col. 4, ll. 21-37).

Regarding dependent claim 52, Rivette-749 discloses that the visual reference is a box with a colored border (Fig. 59).

Regarding dependent claim 56, Rivette-749 discloses that the graphic images of physical pages adhere to a page description format (Fig. 59).

Regarding dependent claim 58, Rivette-749 teaches displaying in a first window a physical page (Fig. 59). The window surrounding the text is the visual reference. Rivette-749 teaches extracting the information on the physical page (col. 19, line 65 – col. 21, line 11). Rivette-749 teaches presenting the extracted information in a second window and that the information is free-flowing (Fig. 59). Rivette-749 discloses that the step of advancing extracted information in the second window further comprises the step of advancing the physical page displayed in the first window (col. 17, ll. 17-25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 5,19,20,29 and 48 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette-749, and further in view of Rivette et al. (US005806079A, granted 9/8/1998) hereinafter Rivette-079.

Regarding dependent claim 5, 29, and 48, Rivette-749 discloses the second window is an enhanced interactive window including a thumbnail image of a physical page, a graphic image of a physical page, text, free flowing text, icons, menus, and control elements (Fig. 59). Rivette-749 does not explicitly disclose hyperlinks. Rivette-079 teaches hyperlinks in document browser (col. 1, ll. 55-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to use hyperlinks in order to link related documents (Rivette-079, col. 1, ll. 43-54).

Regarding dependent claim(s) 19, Rivette-749 does not teach hyperlinks. Rivette-079 teaches hyperlinks as described in claim 5 above. Official Notice is taken that it was well known and desired in the art at the time of the invention to displaying hyperlinks as hypertext.

Regarding dependent claim(s) 20, Rivette-749 does not teach hyperlinks. Rivette-079 teaches hyperlinks in document browser (col. 1, ll. 55-60) that link to documents, which are visual elements. It would have been obvious to one of ordinary skill in the art at the time of the invention to use hyperlinks in order to link related documents (Rivette-079, col. 1, ll. 43-54).

7. Claims 39-41 and 53 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette-749, and further in view of Reed et al. (US005241671A, granted 8/31/1993).

Regarding dependent claims 39 and 53, Rivette-749 does not explicitly disclose a dictionary. Reed discloses presenting a dictionary to a user to retrieve definitions (col. 14, ll. 28-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a dictionary to allow the user to look up words they did not know (Reed, col. 14, ll. 28-29).

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Regarding dependent claim 40, Rivette-749 does not explicitly disclose a dictionary. Reed discloses presenting an information database to a user to retrieve definitions for unfamiliar words (col. 14, ll. 28-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a dictionary to allow the user to look up words they did not know (Reed, col. 14, ll. 28-29).

Regarding dependent claim 41, Rivette-749 does not explicitly disclose a dictionary. Reed discloses examining extracted information for unfamiliar words and displaying definitions for the unfamiliar words (col. 14, ll. 28-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a dictionary to allow the user to look up words they did not know (Reed, col. 14, ll. 28-29).

8. Claim 54 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette-749.

Regarding dependent claim 54, Rivette-749 does not explicitly disclose a lock. Official Notice is taken that it was well-known and desirable in the art at the time of the invention to secure any information to one device.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-10, 29, 44, 46-51, and 57 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, and 20 of copending Application No. 10/691,927 in view of Rivette-079.

The copending application teaches all elements of the instant claims except free-flowing text. Rivette-079 teaches free-flowing text (Fig. 59). It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize free-flowing so that parts of the document would not be cut off.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

11. Applicant's arguments filed 01/20/2006 have been fully considered but they are not persuasive.

Regarding Applicant's remarks on Paragraph 2-5 of the response:

Applicant has changed "a visual reference emphasizing information on a portion of the at least one physical page" to "a visual reference disposed on the physical page." It is not seen how this change is intended to overcome the previous rejection and rationale. The visual reference of Rivette-749 is still disposed on the physical page. Applicant further alleges that Fig. 59 does not teach a physical page, since the bottom margin is not shown. However, as is clear from the disclosure as a whole, the image on the right is the physical page representation is the image of the published patent, which is a physical page. While, margins are not specifically recited, an actual page must have these margins. Rivette's meaning is confirmed (col. 14, ll. 50-67) by the

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fact that it is an image of the physical page. Certainly, a physical page showing all 4 margins would not cease to become a physical page merely because it is shown in a view or zoom that does not show all of them.

Regarding Applicant's remarks on Paragraph 6 of the response:

Applicant alleges that since the instant application predates the cited application, a double patenting rejection is improper. However, while such an argument is valid for prior art under § 102, paragraphs a, b, or e, there is no such requirement for a double patenting rejection. The considerations for an application to be available for a double patenting rejection, in this case, are that they are co-pending, and that they share at least one common inventor. Priority date is not a valid consideration.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

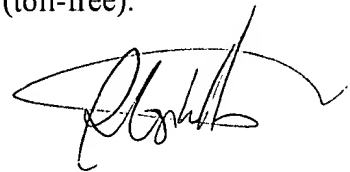
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140.

The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ



STEPHEN HONG
ASSISTANT PATENT EXAMINER